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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 09/777,077 | 02/05/2001 | Dimitri Kanevsky | YOR920000475US1(13823) | 9551 |

7590 05/17/2004

Richard L. Catania
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Garden City, NY 11530

EXAMINER

GART, MATTHEW S

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,077

Applicant(s)

KANEVSKY ET AL.

Examiner

Matthew s Gart

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/3/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/3/2004 has been entered.

Claims 1-21 are pending in the instant application.

Drawings

The drawings were received on 8 January 2004. The Examiner accepts these drawings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by
Allen U.S. Patent No. 6,041,316.**

Referring to claim 1. Allen discloses an application system running in a central processing unit for changing the appearance and performance generated by a specified application, the system comprising, a timer for measuring time, and means, responsive to the timer, to change, after receipt of the specified application by the central processing unit, the appearance or performance generated by the specified application according to a timed procedure to encourage a user of the application to abandon this specified application and to purchase a new version of the specified application (column 7, line 10 to column 8, line 57).

Referring to claim 2. Allen further discloses a system where changing of the appearance includes change color (column 8, lines 22-25).

Referring to claim 3. Allen further discloses a system wherein changing of the performance includes features that gradually drop out (column 7, lines 47-65).

Referring to claim 4. Allen further discloses a system where changing in the program appearance leads to degradation of the view of the application (column 8, lines 18-26).

Referring to claim 5. Allen further discloses a system where changes in performance lead to degradation of performance (column 7, line 10 to column 8, line 57).

Referring to claim 6. Allen further discloses a system where colors, contrast and fonts are degraded (column 8, lines 22-25).

Referring to claim 7. Allen further discloses a system where changes are adjusted to time and starts after some time limits (column 8, lines 43-57).

Referring to claim 8. Allen further discloses a system where adjustment to time means gradual changes (column 8, lines 43-57).

Referring to claim 9. Allen further discloses a system where the system is part of the specified application (column 7, line 10 to column 8, line 57).

Referring to claim 10. Allen further discloses a system where changes are obtained by manipulating drives in PC (column 7, line 10 to column 8, line 57).

Referring to claim 11. Allen further discloses a system where users pay money or view advertisements to reduce or eliminate degradation (abstract).

Referring to claim 12. Allen further discloses a system where money is paid to any of: software manufacturer, seller, third party, or degradation service provider (abstract).

Referring to claim 13. Allen further discloses a system where the amount of degradation is related to the amount of money paid (abstract).

Referring to claims 14-16. Claims 14-16 are rejected under the same rationale as set forth above in claims 1-13.

Referring to claims 17-19. Claims 14-16 are rejected under the same rationale as set forth above in claims 1-13.

Referring to claims 20-21. Claims 14-16 are rejected under the same rationale as set forth above in claims 1-13.

Response to Amendment

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The Applicant's amendment filed 5/3/2004 to claims 14-16, 20 and 21 overcome the rejection under 35 U.S.C. 101

Response to Arguments

Applicant's arguments filed 5/3/2004 have been fully considered but they are not persuasive.

The Attorney argues that Allen does not disclose the feature that the trial or demonstration version of the software diminished after being received by the user machine or computer over time.

The Examiner notes, Allen does disclose a method wherein the software is diminished after being received by the user machine or computer over time. In the method described by Allen and the instant invention it doesn't matter what form the data is in at the instance it is originally downloaded, in both instances the data includes a time limitation such that the data is destroyed or otherwise rendered unusable after elapse of a predetermined time (Allen: column 7, lines 46-65). Even though in Allen the data might be "partially degraded", this data is substantially recognizable to the consumer as a particular type of data and is therefore suitable for use in browsing and/or research or for other purposes which do not require full resolution undegraded data (Allen: column 4, lines 30-35).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Conclusion

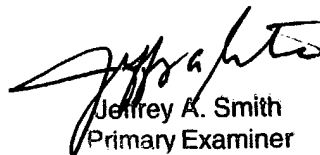
Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

January 28, 2004


Jeffrey A. Smith
Primary Examiner